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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/767,607	01/22/2001	Kevin A. Owen	10002024-1	2528

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
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EXAMINER

PHAM, THIERRY L

ART UNIT	PAPER NUMBER
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2624

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/767,607	Applicant(s) OWEN ET AL.	
	Examiner Thierry L Pham	Art Unit 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/17/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

- This action is responsive to the following communication: an Amendment filed on 11/17/04.
- Claims 1-9, 11-20 are pending in application; Claim 10 has been canceled.
- Response to objection of claim 10 for "Duplicate claim" has been acknowledged. Objection of claim 10 has been withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-8, 11-17, 19-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Kageyama (U.S. 6333790).

Regarding claim 1, Kageyama discloses a hardcopy device (printer, fig. 2) comprising:

- a processor (printer controller includes MPU, fig. 6);
- an image printing unit (printer engine, fig. 6) which is controlled by said processor and fed by a print media supply and handling unit (inherently known in the art that all printers include print media handling and supplying unit); and
- a memory unit (RAM memory, fig. 6) containing an electronic document file (information file describing printer's features and its usage, fig. 10) which is retrieved, on command (commands from host computer and/or via control panel, fig. 1 and fig. 6), from said memory by said processor and printed in hardcopy form by said image printing unit;
- wherein said electronic document file is a document describing features of said hardcopy device (information file describing printer's features and its usage, fig. 10, col. 5, lines 60-67 to col. 6, lines 1-18).

Regarding claim 2, Kageyama further discloses the device of claim 1, wherein said memory unit is a read-only memory unit (ROM memory, fig. 6) and contains said electronic document file.

Regarding claim 3, Kageyama further discloses the device of claim 1, further comprising a user interface unit (user operating control panel, fig. 6) with which a user can issue a command for said device to print said electronic document file in hardcopy form.

Regarding claim 4, Kageyama further discloses the device of claim 3, wherein said user interface unit displays (user operating control panel, fig. 6) a menu from which said command is issued in response to selection of a corresponding menu item.

Regarding claim 5, Kageyama further discloses the device of claim 3, further comprising a display associated with said device which advertises a specific manipulation (fig. 10) of said user interface device that will issue said command.

Regarding claim 6, Kageyama further discloses the device of claim 1, further comprising a connection to a host device (fig. 1), wherein said host device issues said command to print said electronic document file.

Regarding claim 7, Kageyama further discloses the device of claim 1, further comprising a connection to a host device, wherein an updated electronic document file (download information from the host, cols. 14-15) is downloaded from said host device to said hardcopy device.

Regarding claim 8, Kageyama further discloses the device of claim 1, farther comprising a static memory unit (fig. 6) in which said updated electronic document file is stored.

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Regarding claim 11, Kageyama further discloses the device of claim 1, wherein said hardcopy device is a facsimile machine (col. 10, lines 58-67) further comprising a modem and connection to a phone line.

Regarding claim 12, Kageyama further discloses the device of claim 11, wherein said facsimile machine further comprises an update subroutine (updating, cols. 14-15) which causes said facsimile machine to connect via said phone line to a host system from which an updated electronic document file is downloaded.

Regarding claims 13-17, 19-20 recite limitations that are similar and in the same scope of invention as to those in claims 1-8, 11-12 and combination thereof; therefore, claims 13-17, 19-20 are rejected for the same rejection rationale/basis as described in claims 1-8, 11-12.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9 & 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kageyama as described in claims 1 and/or 13 above, and in view of Lee (U.S. 6628413).

Regarding claims 9 & 18, Kageyama does not disclose wherein hardcopy device comprising an embedded Web Browser for downloading an updated electronic document file from the Internet or Web.

Lee, in the same field of endeavor for printer, teaches a hardcopy device comprising an embedded Web Browser (Java printer comprising a Web Browser for downloading/updating updated parameters, col. 5, lines 8-65) for downloading an updated electronic document file from the Internet or Web.

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It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Kageyama as per teachings of Lee because of a following reason: (1) to allow operators/users to connect to the WEB from the printer without having to use the host computer; therefore, reducing hardware costs.

Therefore, it would have been obvious to combine Kageyama with Lee to obtain the invention as specified in claims 9 & 18.

Response to Arguments

Applicant's arguments filed 11/17/04 have been fully considered but they are not persuasive.

- Regarding claim 1, the applicants argued the cited prior art of record (US 6333790 to Kageyama) fails to teach and/or suggest printing the “information file” describing the printer’s features and its usage as shown in fig. 10.

In response, Kageyama explicitly teaches a printer (printer 200, fig. 2) including printer engine 2200. Printer 200 also includes user-operating panel 607 as shown in fig. 200 allowing user to access contents stored in RAM 60A and/or individual printer management part 2120 (fig. 2), col. 9, lines 32-34. Printer 200 also includes a printer engine 2200 for printing data onto physical media (i.e. paper and/or transparency). Fig. 10 shows an example of “information file” stored in printer’s memory device, this “information file” can be transmitted to a remote computer and/or can be printed out using printer engine 2200, please see col. 6, lines 53-60. Inherently, any data stored in printer’s memory are printable by printer engine 2200.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- U.S. 5283661 to Klees, teaches a facsimile apparatus with its features stored in a memory device. Operator can access these features via control panel and prints out these features on a physical media (i.e. paper media), see col. 2, lines 15-25 and col. 5, lines 56-67.
- U.S. 5363204 to Millman, teaches a facsimile apparatus with a “help” menu allowing operators to print out its features as shown in fig. 3.

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- U.S. 6501485 to Dash et al, teaches a multifunctional printer comprising a control panel interface for accessing features that are incorporated within the printer.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L Pham whose telephone number is (571) 2727439. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thierry L. Pham



**GABRIEL GARCIA
PRIMARY EXAMINER**